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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/765,763

01/19/2001

Roger P. Hoffman

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07/14/2005

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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,763

Applicant(s)

HOFFMAN, ROGER P.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3/31/2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 and 17 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Computers, databases and network elements are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Claim 10 does not indicate any tools to enable said method steps to be performed. Claim 17 does not recite any one structural element.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claims 4-5 and 8. The Claim refers to a system while reciting a search engine, which is confusing. Microsoft Computer Dictionary, 4th ed. 1999, p. 399, defines the term "search engine" as "a program that searches for key-words in documents or in a database". The program is a set of computer-readable instructions, and not a structural element.

As per Claim 6. The Claim refers to a system while reciting information, which is confusing. Information is not a structural element.

As per Claim 7. The Claim refers to a system while reciting information (product specification charts), which is confusing. Information is not a structural element.

As per Claim 9. The Claim refers to a system while reciting "online communication between individuals", which is confusing. The "online communication between individuals" appears to be a method step and not a structural element.

As per Claim 10. The Claim is confusing because the term "said system" lacks antecedent basis.

As per Claim 11. The Claim refers to a database while reciting a system, which is confusing. The term "system" is commonly understood as an apparatus.

As per Claims 12-16, the Claims are rejected as being dependent on the independent Claim 11.

As per Claim 17. The Claim refers to a system while reciting information, which is confusing. Information is not a structural element.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently

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acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Contrary to the claims in the above-cited cases, in the present application, the claims are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The method claims are no more than a suggested idea of advising regarding energy consumption based on the market energy prices. The claims are completely devoid of any means to carry out a process implementing the step of: *entering job characteristics of a user*. Furthermore, language as to "*wherein said system creating said integrated portal system based on said job characteristics*" appears to be suggestive, and could be understood as merely a business schema.

Section 100 (b) of Title 35 U. S. C. defines "process" to mean "process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." "When Congress approved the addition of the term "process" to the categories of patentable subject matter in 1952, it incorporated the definition of "process" that had evolved in the courts" (footnotes omitted), See *In re Schrader*, 22 F. 3d 290, 295, 30 USPQ2d 1455, 1459 (Fed. Cir. 1994), which included this definition from *Cochrane v. Deener*, 94 U. S. 780, 788 (1877): "A process is ... an act, or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing."

Claims in the present application do not transform any physical subject matter or tangible (matter) into a different state of thing, and can be performed manually by a human.

The examiner recognizes that a statutory "process" under § 101 does not have to be performed by a machine, there must be a transformation of physical subject matter from one state to another, e.g., a step of "mixing" two chemicals transforms two separate chemicals into a manufacture or a composition of matter, regardless of whether it is performed by a human or a machine.

Claims in the present application do not recite transformation of physical subject matter.

The examiner further recognizes that "subject matter" transformed does not need to be a physical (tangible) object or article or substance. Under the *State Street* test transformation of electrical signals into a different state or signal within a computer could constitute a machine implementation if the result has some practical utility.

However, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data. Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) a network or a system, or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

As to "wherein" clause, it merely states the intended use of the invention, or the result of the limitations in the claim, and adds nothing to the patentability of the claim.

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Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-5, 7, 9-13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Chipman et al. (US 6,292, 894).

Chipman et al. (Chipman) teach a method and system for retrieving, organizing and utilizing networked data, comprising:

As per claim 1,

an industry related portal (column 4, lines 10-17);

a second portal of a different industry (column 4, lines 10-17);

said system integrating said portals so that a user can view information relating to both portals in a single system (column 2, lines 46-54; column 3, lines 51-65).

As per claim 2, said method and system, wherein said user can order part or services (column 12, lines 40-41).

As per claims 4-5 and 9, said method and system, further comprising a search engine (column 6, line 63 – column 7, lines 14).

As per claim 7, said method and system, further comprising product specification information (column 9, lines 56-63).

As per claim 10, said method and system, wherein the integrated portal system is created based on entering job characteristics of a user (column 7, lines 37-56).

As per claim 11, said method and system, comprising an industrial database comprising a search engine; said database having product or service specifications, product reports product and a system for answering questions from a user (column 5, lines 59-62; column 6, line 63 – column 7, lines 14; column 10, lines 26-34).

As per claims 12-13, said method and system, comprising a list of vendors and vendor product information (column 9, lines 36-65).

As per claim 16, said method and system, wherein said database provides a price analysis mechanism (column 12, lines 37-38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 8, 14-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chipman.

As per claims 3, 8 and 17, Chipman teaches all the limitations of claims 3, 8 and 17, including a governing portal for each industry, and other portals in that industry, except specifically teaching that said portals include a *mini* portal and *macro* portal.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The functions performed

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by said system would be the same regardless of the definition of the recited portals.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

As per claims 14 and 15, Chipman teaches all the limitations of claims 14 and 15, except specifically teaching characteristic and usage templates. However, Chipman does teach that information in a database can be presented in a template form, said information specifying the supplied products and processes (column 10, lines 25-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include that said template is a characteristic or usage template, because it would advantageously simplify the processing of information.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chipman in view of Rangan (US 6,412,073).

As per claim 6, Chipman teaches said method and system, including ontology tracking component (column 11, lines 35-37).

Chipman does not specifically teach that the ontology tracking component includes transaction-tracking component.

Rangan teaches a method and system for user-interactive portals accessible via the Internet, wherein a facility is provided for automatically tracking transactions made at various destinations (column 8, lines 20-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chipman to include transaction tracking component, as disclosed in Rangan, because it would advantageously allow to automate processing of the transactions for the users, as specifically stated in Rangan (C. 8, L. 19-23).

Response to Arguments

Applicant's arguments filed 3/31/2005 have been fully considered but they are not persuasive.

In response to applicant argument that Chipman et al. (Chipman) teaches a portal which relates to only one industry, and does not relate to multiple industries, it is noted that Chipman explicitly teaches a plurality of various industries. Specifically, an advantage of Chipman's system is shown as overcoming the existing problem of current design which does not allow to integrate various electronic tools in such application fields (sectors) as computer aided design, structural analysis, costing, manufacturing, planning, etc. Furthermore, Chipman teaches: "*The problems associated with the current design and manufacturing model exist in other industry sectors as well. For example, the real estate industry uses as its primary search and indexing tool the multiple listing service (MLS). However...there is no ability to link to other sources of other information, for example, financial institutions providing loan information*" (C. 2, L. 2-20).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a person who is in charge of delivery and logistics for a company") are not recited in the rejected Claim 10. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine Chipman and Rangan, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one

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of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references relate to providing and maintaining a user-interactive portal system accessible over the Internet. The motivation to combine the references would be to allow to automate processing of the transactions for the users, as specifically stated in Rangan (C. 8, L. 19-23).

Conclusion

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Hayes, can be reached at (571) 272-6708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

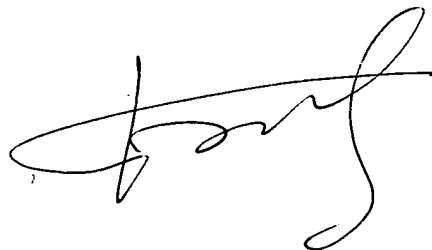
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Igor Borissov
Patent Examiner
Art Unit 3639



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